

REMARKS

In response to the Office Action of July 16, 2003 from the Examiner in charge of the subject application, the following remarks regarding the rejections are respectfully submitted for consideration.

Rejection under 35 USC 112

Claims 1-25 have been rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

Applicants maintain the position set forth in their Reply of May 27, 2003. See *In re Johnson and Farnham* 194 U.S.P.Q. 187, 196 (CCPA 1977) in which it is stated:

Here, as we hold on the facts of this case, the "written description" in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter."

The case law is clear in *In re Johnson and Farnham* that Applicants are permitted to exclude the prior art. Reconsideration and withdrawal of the rejection and admittance of Applicants' amendment to claim 1 are respectfully requested.

Rejection under 35 USC 103(a)

Claims 1-7 and 9-25 have been rejected under 35 USC 103(a) as being unpatentable over PPG Industries PCT application WO 98/37115 in view of Ammons (U.S. Patent 4,101,529). Applicants respectfully traverse this rejection and request that it be reconsidered and withdrawn.

The combination of PCT application WO 98/37115 and Ammons (U.S. Patent 4,101,529) does not make Applicants' invention

obvious. The primary reference PCT application WO 98/37115 does not disclose or suggest the use of polycarbonate polyols in the preparation of polyurethane coatings. The secondary reference Ammons (U.S. Patent 4,101,529) is directed to hard polyurethane articles that could be used as substitutes for glass in applications such as aircraft glazings and optical lenses, as described in column 1, lines 12-38 and column 8, lines 44-48. The use of photochromic compounds in such articles is not disclosed, although the reference teaches the optional inclusion of a polymeric polycarbonate diol in preparing the polyurethane article.

One skilled in the art would not look to Ammons (U.S. Patent 4,101,529) for guidance on formulating photochromic polyurethane coatings. The disclosure in Ammons does not guide one skilled in the art toward making photochromic coatings since it is directed to "hard" polyurethane articles characterized by, among other properties, a Shore D hardness of at least 75 at room temperature. Shore D hardness is generally utilized for determining indentation hardness of solid polymeric materials rather than films.

Applicants' invention is directed to a photochromic article having a photochromic polyurethane coating. Accordingly, there is no teaching, suggestion or motivation in the primary reference that deals with an article having a photochromic polyurethane coating to look to Ammons dealing with solid polymeric materials, to combine such references. Ammons does not even disclose the use of photochromic materials for any purpose, let alone for use in a coating.

There is no suggestion or motivation to combine the references of PCT application WO 98/37115 with Ammons (U.S. Patent Ammons (U.S. Patent 4,101,529)). Therefore, the combination of PPG Industries PCT application WO 98/37115 in view of Ammons (U.S. Patent 4,101,529) does not make Applicants' invention obvious.

In view of the above remarks, reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a) are respectfully

requested. Allowance of all of Applicants' presenting pending claims is respectfully requested.

In the event that the Examiner finds that the foregoing remarks do not place this application in condition for immediate allowance, it is requested that the Examiner contact Applicants' Agent at the telephone number found below to arrange for an interview to discuss the claims of the present application before the Examiner issues another Communication.

Respectfully submitted,

  
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